



PATENT
Customer No. 22,852
Attorney Docket No. 06502.0338-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Michael SIJACIC et al.)	Group Art Unit: 2195
)	
Serial No.: 09/867,650)	Examiner: N. Shah
)	
Filed: May 31, 2001)	
)	Confirmation No.: 7983
For: METHODS AND SYSTEM FOR)	
DEFINING AND CREATING)	
CUSTOM ACTIVITIES WITHIN)	
PROCESS MANAGEMENT)	
SOFTWARE)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated June 16, 2005. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicants concurrently file the Request with a Notice of Appeal and prior to an Appeal Brief; and (3) Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness In Rejecting Claims 1-11 view of *Falls et al.* and *Remington et al.*

Notwithstanding Applicants' position that the cited art does not teach the recitations of claims 1-29 and 36-91, as asserted by the Examiner (issues that will not be reviewed by the Pre-Appeal Brief Conference Panel), Applicants note that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1-11 in view of *Falls et al.* and *Remington et al.*

In rejecting claim 1 in the first Office Action on the merits, the Examiner asserted it would have been obvious to combine *Falls et al.* and *Remington et al.* "because Remington's method of automating certain process would make Falls system more efficient but having less user interaction." (See Office Action dated 12/22/04, at 3, ¶ 7.) Applicants specifically addressed the legal deficiencies in the Examiner's position in the Amendment filed March 21, 2005, which are incorporated herein by reference. (See Amendment, 3/21/05, at 6-7.) In response, the Examiner issued a Final Office Action reiterating the same rejections set forth in the first Office Action, including the asserted reasons for combining the references. (See Final Office Action dated 6/16/05, at 3, ¶ 6.) In addition, the Examiner addressed Applicants' arguments regarding this issue in a single sentence and cite to *Remington et al.* (See Final Office Action at 16, ¶ 52(d).) Neither the rejection of claim 1, nor the Examiner's comment on page 16 of the Final Office Action meet the requirements for establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, among other things, there must be some suggestion or motivation, either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143. The Examiner failed to meet at least this requirement.

The Examiner's reason for combining the reference is conjecture. Nowhere does ¶ 6 of the Final Office Action show where "in the references themselves" or "in the knowledge available to one of ordinary skill in the art" there is a proper motivation. Instead, the Examiner concludes it would be obvious to combine an electronic bill presentment and payments (EBPP) system with a file synchronization system because of efficiency and "less user interaction." (See Office Action at 3, ¶ 6). This reasoning does not meet the standard for establishing a *prima facie* case of obviousness.

Nor does the Examiner's reference to *Remington et al.* in ¶ 52(d) of the Final Office Action cure this deficiency. Indeed, column 13, lines 27-31 of *Remington et al.* merely describes functions associated with a payment remittance user interface. There is absolutely no disclosure or suggestion in this portion, or any other portion, of *Remington et al.* that would motivate one skilled in the art to use the EBPP system with a data file synchronization environment. In fact, the Examiner points to no evidence that shows *Remington et al.* was even concerned with such technological issues.

Moreover, the Examiner did not show where *Falls et al.* provides any explicit or implicit suggestions for using, or being concerned with, an EBPP system with its file synchronization processes. For instance, because *Falls et al.* may perform its file "correspondency" processes automatically or through user interaction (See *Falls et al.*, col. 9, lines 11-19), there would be no reason or motivation for one of ordinary skill in the art to look to *Remington et al.* to modify *Falls et al.* to make its system "more

efficient but[sic: by] having less interaction,” as asserted by the Examiner. (Final Office Action at 3, ¶ 6.)

In light of the above arguments and those presented in the March 21 Amendment, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claim 1 and its dependent claims 2-11. Therefore, the rejections should be withdrawn and the claims allowed.

III. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness In Rejecting Claims 12-29 and 36-91 view of *Falls et al.* and *Remington et al.*

As explained in the March 21 Amendment, the first Office Action was deficient because the Examiner did not present any evidence to support the alleged combination of *Falls et al.* and *Remington et al.* to allegedly render claims 12-29 and 34-91 obvious. (Amendment filed 3/21/05, at 13.) In the Final Office Action, the Examiner reiterated the same rejection and ignored Applicants’ arguments regarding this issue, and thus has the same deficiency: The Examiner did not establish a *prima facie* case of obviousness with regard to these claims. Accordingly, for at least the reasons set forth in the March 21 Amendment, Applicants request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

IV. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness In Rejecting Claims 30-33 view of *Remington et al* and *Sharma et al.*

Additionally, the Examiners’ reasons for combining *Sharma* and *Remington et al.* is conjecture. (See *Office Action* at 14, ¶ 46.) The Examiner did not point to any suggestion found “in the references themselves” or show why one of ordinary skill in the art would look to either reference to make the asserted combination. Instead, the Examiner offers an unsupported conclusion that the motivation is based on “having the

date[sic:data] secure and safe from a restricted party. The Examiner does not properly explain why one of ordinary skill in the art would look to a SQL-based query processing system to modify the EBPP system disclosed by *Remington et al.* Nor does the Examiner show where either reference discloses a suggestion to do so. As such, the Examiner has not established a *prima facie* case of obviousness with respect to claims 30-34. Therefore, Applicants request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.


V. Conclusion

Because the Examiner's rejections of claims 1-91 includes legal deficiencies with regard to under 35 U.S.C. § 103(a) and the M.P.E.P., Applicants are entitled to a pre-appeal brief review of the Final Office Action. And based on the foregoing arguments, Applicants request that the rejection of these claims be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: September 15, 2005

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